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09/675,252	09/29/2000	Satoshi Washizuka	1035-283	1246

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/675,252

Applicant(s)

WASHIZUKA ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is in response to amendment filed 9/8/2004.

***Response to Amendment***

2. Claims 1 and 18 have been canceled. Claims 2-17 and 19 have been amended and new claims 20-27 have been added per request.
3. The title of the application has been changed per request.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejections.

***Claim Rejections - 35 USC § 112***

5. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claim 16 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of the system. The claim recites a buyer terminal, a reconciliation unit and a seller terminal as limitation of a system and subsequently the claim then deals with the specifics of a method steps which are predicated upon the system limitations such as "creating in said buyer terminal purchase request data" etc.

6. Claims 6-14 are rendered indefinite because they do not further limit the system or apparatus of the parent claim. Example: claim 6 describes the reconciliation unit without reciting any structural element of the reconciliation unit, which would further limit the reconciliation unit and which performs the act recited the claim. Therefore, claims 6-9 are treated as non-functional descriptive material. To correct this deficiency the claims must show structural elements of the reconciliation unit, which carry out these acts or functions.

7. Similarly claims 10-14 contain the following deficiencies.

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As an example, Claim 10 further limits the seller terminal as including an input device. However, it also describes the functions performed by the seller terminal without reciting any structural elements (e.g. means for ..). Claims 11-14 contain similar deficiencies.

Based on the foregoing analysis claims 6-14 are analyzed as being indefinite and failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 101***

8. Claim 16 is rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two

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different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a method (ex. Preamble of claim 16), the body of the claim discusses the specifics of the system and method ((see 112(second) rejection)). (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). "a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte Lyell (17USPQ2d 1548).

### ***Claim Rejections- 102***

A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

Claims 2-15, 17, 19, 20, and 22-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Walker et al. (US 5,794,207) (Walker).

Claim 17 Walker-207 discloses an account reconciliation server (central controller 200, see Fig. 1 and 2), which

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guarantees account reconciliation in purchase transactions between a buyer and a seller of a product or service ,

said account reconciliation server comprising:

a communicating circuit means for establishing communications with each of a buyer terminal of the buyer and a seller terminal of the seller;

(Fig. 1 network interface 245)

credit data creating means for creating, based on purchase request data received from the buyer terminal, credit data including information which specifies purchase transaction conditions for the product or service, and sending the credit data created to said seller terminal, said credit data guaranteeing account reconciliation for the product or service;

(CPU 205 and payment processor 230 connected to data storage device 250, see at least Fig. 2 and col. 12 L 35-46)

delivery list creating means for creating and sending to said buyer terminal delivery list data relating to delivery of the product or service when the product or service is received from the seller;

(see at least Fig. 2 purchase confirmation database 275. and col. 13 L 39-43.). Purchase confirmation database 275 tracks the messages sent to the buyer and seller confirming completed

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transactions (bound contracts). Fields include buyer name, buyer ID number, seller name, seller ID number, purchase confirmation tracking number, and associated CPO tracking number.)

claiming means which, when acceptance data for the delivery list data is received from the buyer terminal, causes the ' the product or service to be delivered to the buyer, and sends a claim to the buyer for payment for the product or service.

(see at least col. 17 L 27-47 .. at step 610, payment processor 230 submits a pre-authorization of the price of CPO 100 to the credit card clearinghouse.)

Claim 19: An account reconciliation server which guarantees account reconciliation in a purchase transaction between a buyer and a seller of a product or service,

said account reconciliation server comprising:

a communicating circuit means for establishing communications with each of a buyer terminal for the buyer and a seller terminal for the seller;

(see claim 17 analysis)



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credit data creating means for creating, based on purchase request data for the product or service supplied from the buyer terminal credit data including information which specifies purchase transaction conditions for the product or service , and sending the credit data to said seller terminal means, said credit data guaranteeing payment to the seller for the supplying of the product or service; (see at least col. 17 L 27-47 .. at step 610, payment processor 230 submits a pre-authorization of the price of CPO 100 to the credit card clearinghouse.) and

claiming means for, when acknowledgement data is received via said seller terminal, sending payment data to said seller terminal for the product or service, while billing the buyer for the payment for the product or service , said acknowledgement data being issued by said buyer terminal when the buyer receives from the seller the product or service which is based on content of the credit data and when the content satisfies the purchase transaction conditions in the credit data.

(col. 9 L 31-44 Escrow account 299 allows payment to be delayed until the seller completes delivery of the goods, while at the same time ensuring that the buyer will in fact make payment. Central controller 200 establishes escrow account 299

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as a temporary holding account. When the seller binds CPO 100 at step 1110, funds are transferred from buyer account 297 to escrow account 299. Only after the goods have been received by the buyer are funds transferred from escrow account 299 to seller account 298.)

Claim 20: An accounting and reconciliation system comprising:

a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service;

(Fig. 3 seller interface 300, modem 350)

a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service;

(Fig. 4 buyer interface 400, modem 450)

a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal, (see Fig. 2 central controller) the reconciliation unit comprising:

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communication circuitry for communicating with the buyer terminal and the seller terminal;

(network interface 245) and

a processing system responsive to the purchase request data for sending the credit data to the seller terminal, and for sending the payment data to the seller terminal after receiving acknowledgment data indicative of the buyer's acknowledgment of receipt of the product or service.

(Figures 2 and 6, col. 9 L 32-44, see col. 22 "delayed payment embodiments)

Claim 2: The accounting and reconciliation system as set forth in claim 20, wherein:

said seller terminal includes an input device usable by the seller to input an estimate in response to an estimate request from the buyer for a product or service to be supplied,

(see Fig. 3 input device 345 see also corresponding description)

said seller terminal creates estimate data based on the estimate and sends the estimate data to said buyer terminal, and

(col. 19 L 55-59)

said buyer terminal receives the estimate data and creates the purchase request data based on the received estimate data.

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(col. 19 L 55-59)

Claim 3: The accounting and reconciliation system as set forth in claim 2 wherein:

said buyer terminal includes a display for displaying content of the received estimate data, and an input device usable the buyer to accept the content of the displayed estimate data, and

said buyer terminal creates the purchase request data upon acceptance of the content of the estimate data.

(col. 19 L 55-59, display device is inherent to the online access by the buyer described at col. 15 L 45+)

Claim 4: The accounting and reconciliation system as set forth in claim 3, wherein:

the estimate data contains information which specifies first and second payment methods, and

said buyer terminal prompts the buyer via said display to confirm that the second payment method may be used if the first payment method fails.

Claim 5: The accounting and reconciliation system as set forth in claim 20, wherein:

said buyer terminal includes an input device usable by the buyer to input information which relates to one or more of an

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effective period of the purchase request data, delivery date of the product or service services, delivery method of the product or service, possibility of separate delivery, and due date of payment from a bank, and

said buyer terminal incorporates the input information in the purchase request data.

(col. 17 L 36-41, col. 16 L 46 "expiration date" to the CPO)

Claim 15: The accounting and reconciliation system wherein the buyer terminal comprises a cellular phone.

(see col. 11 L 61+ Connection may also be provided by dedicated data lines, **cellular**, Personal Communication Systems ("PCS"), microwave, or satellite networks)

Claim 21: Walker discloses an accounting and reconciliation system comprising:

a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service;

(Figure 3 seller interface, and Figures 9 and 11 )

a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product

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or service, receiving delivery list data relating to delivery of the product or service, and sending acceptance data in response to the delivery list data;

(Figure 4 Buyer interface, Figures 5 and 13)

and

a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal to the reconciliation unit, the reconciliation unit comprising: communication circuitry for communicating with the buyer terminal and the seller terminal;

(Fig. 2, central controller 200, and process performed by the central controller as shown in Figures 6-8, refer also to the appropriate sections of the Detailed Description)

a processing system responsive to the purchase request data for sending the credit data to the seller terminal and for sending the payment data to the seller terminal after the product or service is supplied from the seller.

(Figure 11 and col. 19 L 61- col. 20 L 4)

Claims 22-27 are apparatus claims, which recite structure of an apparatus (such as claim 22 recites structure of a reconciliation unit). Examination of the apparatus claims is

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based upon and supported by the following guidelines (see applicable section of MPEP).

Apparatus and Article Claims – Functional Language

For a discussion of case law which provides guidance in interpreting the functional portion of means-plus-function limitations see MPEP § 2181 – § 2186.

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE  
FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. [In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE

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## APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural imitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.

The following analysis of claims 22-27 is based upon the foregoing examination guidelines for an apparatus.

Per Claim 22 Walker disclose a reconciliation unit [for an accounting and reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service, and a buyer terminal



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for a buyer, the buyer terminal sending purchase request data containing purchase transaction information which specifies purchase transaction conditions for the product or service, wherein the reconciliation unit mediates a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal,] the reconciliation unit (see Figure 2, central controller 200) comprising:

communication circuitry for communicating with the buyer terminal and the seller terminal; (Figure 2, network interface 245)

and

a processing system responsive to the purchase request data for sending the credit data to the seller terminal and for sending the payment data to the seller terminal after receiving acknowledgment data indicative of the buyer's acknowledgement of receipt of the product or service.

(Figure 2, CPU 205, payment processor 230 and data storage device 250 connected to buyer and seller terminals; also refer to Figure 11 and col. 19 L 60+)

Claim 23: walker discloses a reconciliation unit (see Figure 2, central controller 200) for an accounting and

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reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service, and a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service, receiving delivery list data relating to delivery of the product or service, and sending acceptance data in response to the delivery list data, wherein the reconciliation unit mediates a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal, the reconciliation unit comprising:

communication circuitry for communicating with the buyer terminal and the seller terminal; (Figure 2, network interface 245)

and

a processing system responsive to the purchase request data for sending the credit data to the seller terminal, and for sending the payment data to the seller terminal after the product or service is supplied from the seller.

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(Figure 2, CPU 205, payment processor 230 and data storage device 250 connected to buyer and seller terminals; also refer to Figure 11 and col. 19 L 60+)

Claim 24: Walker discloses a buyer terminal (see Figure 4, Buyer interface 400) for a buyer for use in an accounting and reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service, and a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving purchase request data, the reconciliation unit comprising communication circuitry for communicating with the buyer terminal and the seller terminal, and a processing system responsive to the purchase request data for sending the credit data to the seller terminal and for sending the payment data to the seller terminal after receiving acknowledgment data indicative of the buyer's acknowledgment of receipt of the product or service, the buyer terminal comprising:

communication circuitry for communicating with the seller terminal and the reconciliation unit; (see Fig. 4, communication port 440 connected to Modem 450)

one or more input devices; (see Fig. 4, input device 445)

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a processing system for sending the purchase request data to the reconciliation unit, the purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service, and for sending the acknowledgement of receipt of the product or service to the reconciliation unit in response an input by the buyer using the one or more input devices.

(central processing unit 405 Fig. 4 which performs purchase request described in Fig. 5).

Claim 25: A seller terminal for a seller for use in an accounting and reconciliation system comprising a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for a product or service, and a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal, the reconciliation unit comprising communication circuitry for communicating with the buyer terminal and the seller terminal, and a processing system responsive to the purchase request data for sending credit data guaranteeing payment for the product or service and for sending payment data for the product or service after

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receiving acknowledgment data indicative of the buyer's acknowledgement of receipt of the product or service, the seller terminal comprising:

communication circuitry for communication with the buyer terminal and the reconciliation unit; and

a processing system for receiving the credit data and the payment data from the reconciliation unit.

(please refer to claim 27 analysis)

Claim 26: A buyer terminal for a buyer for use in an accounting and reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service, and a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving purchase request data, the reconciliation unit comprising communication circuitry for communicating with the buyer terminal and the seller terminal, and a processing system responsive to the purchase request data for sending the credit data to the seller terminal and for sending the payment data to the seller terminal after the product or service is supplied from the seller, the buyer terminal comprising:

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communication circuitry for communicating with the seller terminal and the reconciliation unit; see Fig. 1, Buyer or Seller Interface 400 having a communication port 440 shown in Fig. 4, col. 9 L 18-29, communication links)

one or more input devices; (input device 470)

a processing system [for sending the purchase request data to the reconciliation unit, the purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service, for receiving delivery list data relating to delivery of the product or service, and for sending acceptance data input using the one or more input devices in response to the delivery list data.] (central processing unit 408 Fig. 4 and col. 32-42).

Claim 27: A seller terminal [for a seller for use in an accounting and reconciliation system comprising a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service, receiving delivery list data relating to delivery of the product or service, and sending acceptance data in response to the delivery list data, and a reconciliation unit for mediating a purchase transaction between the buyer and the

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seller in response to receiving the purchase request data sent from the buyer terminal, the reconciliation unit comprising communication circuitry for communicating with the buyer terminal and the seller terminal and a processing system responsive to the purchase request data for sending credit data to the seller terminal and for sending the payment data to the seller terminal after the product or service is supplied from the seller,] the seller terminal comprising:

communication circuitry for communicating with the buyer terminal and the reconciliation unit; (see Fig. 3, communication port 340 and Modem 350) and

a processing system for receiving the credit data and the payment data from the reconciliation unit.

(central processing unit 305 and connected elements show in Fig. 3).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

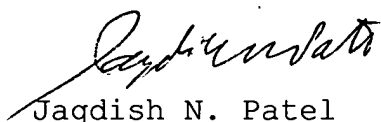
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

11/28/04